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In re Application of : DECISION ON
Deckman et al : PETITION
Application No.: 08/545,707 : UNDER 37 CFR 1.137(b)
PCT No.: PCT/EP94/01301 : AND 1.183
Int. Filing Date: 25 April 1994
Priority Date: 23 April 1993
Attorney's Docket No.: 93A007
For: MOLECULAR SIEVE LAYERS AND
PROCESSES FOR THEIR MANUFACTURE

This decision is responsive to applicant's "RENEWED PETITION TO REVIVE ABANDONED APPLICATION UNDER 37 CFR 1.137" filed 20 August 1997, which was accompanied by a petition under 37 CFR 1.183 requesting a waiver of the one year period in which to file a petition to revive.

The petition under 37 CFR 1.183 is DISMISSED.

The petition under 37 CFR 1.137(b) to revive the above-identified application is GRANTED.

BACKGROUND

The international application became abandoned at midnight on 23 October 1995 for failure to pay the basic national fee by 30 months from the priority date. On 07 November 1997, applicant filed papers for entry into the national stage in the United States. A Notification of Abandonment (Form PCT/DO/EO/909) was mailed on 09 February 1996. The present petition was filed on 20 August 1997.

DISCUSSION

Applicants' counsel Mr. Sherer states that he filed a new application under 35 U.S.C. 111(a) on the 07 November 1995, which contained the "same specification and claims as the PCT-Based Application [the national stage papers for international application

PCT/EP94/01301], but without any priority claim." It is noted that applicants have an application number 08/554,879 filed on 07 November 1997 with the same title and same inventors as the above-captioned application. Mr. Sherer states the following:

- "(7) On February 15, 1996, a Notification of Abandonment for the PCT-Based Application having a mailing date of February 9, 1996 for failure to provide the U.S. Basic National Fee by 30 months was received by the Baytown Office. Upon receipt of the Notification of Abandonment, the Docket Clerk at Baytown, Texas recorded in the Office's Master Docket that a Petition to Revive with the Basic National Fee was due on March 8, 1996 for the PCT-Based Application.
- "(8) Before the end of February 1996, Applicants' attorney began preparing a Petition to Revive under 37 C.F.R. 1.137(b) for the PCT-Based Application. Because an executed Declaration was needed with the Payment of the Basic National Fee to revive the Pct-Based Application and had not been received at the Baytown Office, Applicants' Attorney instructed personnel responsible for obtaining documents for the PCT-Based Application to obtain a Declaration signed by all inventors for submission with the Petition to Revive. Unknown to Applicants' attorney, the Master docket was not amended to reflect that a Declaration was needed in addition to the Basic National Fee for the Petition to Revive for the PCT-Based Application.
- (9) On April 11, 1996 , the Abington [England] Office sent to the Baytown [Texas] Office a signed Declaration for the PCT-Based Application. Since the Master Docket stated that a declaration was needed for the New Application (but did not show that a Declaration was needed with the Petition to Revive for the PCT-Based Application), the Declaration was inadvertently filed at the United States Patent and Trademark Office for the New Application [08/554,879] instead of the PCT-Based Application.

* * *

- (13) The New Application and the PCT- Based Application have very similar serial numbers (08/545,707 versus 08/545,879), the same titles (Molecular Sieve Layers and Processes for Their Manufacture), the same filing dates (November 7, 1995), the same Attorney Docket Numbers (93A007), the same specifications, and the same claims. Because of all these similarities and the incorrect acknowledgement of a priority claim on the Filing Receipt, the Baytown Office assumed that all was in order for protecting the subject invention. The Paralegal responsible for reporting patent formality matters to Applicants' attorney did not understand that the New Application could not

claim priority from the '93 European Application even though it Filing Receipt so indicated. This misunderstanding reasonably led her to assume that the New Application with its priority claim to the '93 European Application was equivalent to the then pending PCT-Based Application. As a result of the misunderstanding, which was based on the incorrect filing Receipt, the Paralegal did not communicate to Applicants' attorney that a Petition to Revive was still outstanding on the PCT-Based Application. Furthermore, no Docket reminders were generated for other actions on the PCT-Based Application because of the failure to enter on the Master Docket that a Declaration was needed with the Petition to Revive (see paragraph (8) and (9)). Hence the present application did not come to the attention of the Applicants' Attorney until the events discussed in paragraph (11).

Applicants assert that docketing error was the cause of delay in filing a petition under 37 CFR 1.137(b) within the one-year time period. Applicants have not supplied a thorough explanation of the docketing and call-up system in use and identified the type of records kept and the person responsible for the maintenance of the system. Applicants have not shown that why, particularly in view of the fact that the Master Docket showed that petition was due on March 8, 1997, the system failed to this instance to provide adequate notice that a petition to revive was due. Applicants have not submitted copies of mail ledger, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing. Applicants have not submitted statement by all persons with direct knowledge of why docket procedures failed, setting forth the facts as they know them.

Applicants have not supplied information regarding the training provided to the personnel responsible for the delay, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

The showing of record is inadequate to establish an extraordinary situation, when justice requires waiver of the rules. Accordingly, the petition under 37 CFR 1.183 to waive the one-year time period present in 37 CFR 1.137(b) is DISMISSED.

However, 37 CFR 1.137(b) was amended on 01 December 1997 to eliminate the one-year period to file a petition under 37 CFR 1.137(b). Therefore, applicants' petition under 37 CFR 1.137 (b) will also be decided under the new rule. Applicants' petition will be accepted and construed as meaning that ""entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional." If this is an incorrect interpretation in view of the rules, petitioner is required to provide a statement to that effect.

If the international filing date of the international application is before June 8, 1995, any petition to revive either under 37 CFR 1.137(b) must be accompanied by a terminal

disclaimer and fee. Applicant has presented a terminal disclaimer and fee. The Terminal Disclaimer filed on 20 August 1997 has been accepted. Since the petition could not be accepted until the new rule took effect on 01 December 1997, the period disclaimed is 26 months, which is equivalent to the period of abandonment.

Any continuing application filed from this application must contain a copy of this decision and a copy of the Terminal Disclaimer. The copies must be filed with a cover letter requesting the terminal disclaimer be recorded on the continuing application.

DECLARATION

The declarations filed on 08 September, 30 October and 13 November 1997 are unacceptable under 37 CFR 1.497(a) because they fail to lists the all the inventors. See MPEP § 602, which states the following:

"When joint inventors execute separate oaths or declarations, each oath or declaration should make reference to the fact that the affiant is a joint inventor together with each of the other inventors indicating them by name."

The declarations only indicates the name of the inventor that signed the declaration as an inventor. Accordingly, the declaration fails to be in compliance with 37 CFR 1.497(a).

CONCLUSION

This application is being forwarded to the National Stage Processing Branch of the International Division for treatment in accordance with this decision, that is, for preparation and mailing of the Notification of Missing Requirements under 35 U.S.C. 371 Form PCT/DO/EO/905.



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